UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,221	04/04/2001	N. S. Ramesh	D-30030-02	2458

28236 7590 08/01/2002

CRYOVAC, INC.
SEALED AIR CORP
P.O. BOX 464
DUNCAN, SC 29334

EXAMINER
VO, HAI

ART UNIT	PAPER NUMBER
1771	3

DATE MAILED: 08/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

mR-3

Office Action Summary	Application No.	Applicant(s)	
	09/826,221	RAMESH, N. S.	
	Examiner	Art Unit	
	Hai Vo	1771	

-- The MAILING DATE of this communication appears on th cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) 22-32 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-21 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-21, drawn to a composite structure, classified in class 428, subclass 304.4.

II. Claims 22-32, drawn to a method of making a composite structure, classified in class 264, subclass 45.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process, such as heat laminating the foam layer to the coating layer.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Thomas C. Lagaly on 07/10/2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-21. Affirmation of this election must be made by applicant

in replying to this Office action.Claims 22-32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hurley et al (US 5,938,878). Regarding claims 1-8, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. ***In re Hutchison***, 69 USPQ 138.

Hurley discloses a laminated structure having a solid core material laminated to the first foam layer on one surface and to a second foam layer on a second surface of core (figure 2). The solid core material of Hurley is analogous to a coating as claimed by the present application. Hurley teaches the laminate wherein the foam layer or solid core material can be a polymer selected from the group consisting of low density polyethylene, polypropylene, ethylene-propylene rubber, ethylene/vinyl acetate copolymer (column 9, lines 20-45). Hurley is silent as to a bond strength of a laminated structure. However, since the laminated structure of Hurley is structurally the same, and made of the same materials as the presently claimed composite. It is the examiner's position that the bond strength within the range as required by the claims would be inherently present in the laminate of Hurley.

With regard to claim 6, Hurley discloses the core is substantially solventless (column 7, lines 9-12).

With regard to claims 7, 8 and 18, Hurley discloses the foam layer having the density of 4 pounds per cubic foot (column 15, line 20).

With regard to claim 20, Hurley discloses polymer structure is used for athletic gear (abstract).

With regard to claim 21, Hurley discloses each of the first foam layer and the second foam layer having a thickness between about 1/32 and ½ inch (column 5, lines 66-67), which overlaps with the presently claimed range. Alternatively, for the non-overlapping part of the ranges, such a variable

would have been recognized by one skilled in the art to control the degree of adhesion between the core and the foam layers. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the foam layers having instantly claimed thicknesses, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. ***In re Aller***, 105 USPQ 233. Since thickness is recognized as a result-effective variable, differences in thickness will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such thickness is critical or provides unexpected results.

7. Claims 1-6, and 9-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Spielau et al (US 4,368,604). Regarding claims 1-6, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. ***In re Hutchison***, 69 USPQ 138.

Spielau discloses an insulating panel having a core layer of two foam sheets **2, 3** of polyolefin foam and a sealing surface layer **5** between the two foam sheets (figure 1). The sealing surface layer of Spielau formed form ethylene vinyl acetate (column 7, line 22) is analogous to a coating as claimed by the present application. Spielau teaches the insulating panel wherein the foam

layer can be polyethylene homopolymer or ethylene/polypropylene copolymer (column 2, lines 49-55). Spielau is silent as to a bond strength of a laminated structure. See inherency rational with respect to claim 1 in paragraph above. With regard to claims 6 and 14, Spielau discloses the sealing layer being a hot melt adhesive; thus it is substantially solventless (column 7, lines 9-12).

8. Claims 7, 8, 16, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spielau et al (US 4,368,604). Spielau does not specifically disclose the foam density. However, such a variable would have been recognized by one skilled in the art as dependent upon the intended use of the product, such that the higher density of the foam, the tougher surface of the panel and lower density of the foam, the smoother surface of the panel. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ foam layer with the density instantly claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. ***In re Aller***, 105 USPQ 233. With regard to claim 20, it has been held that a recitation with respect to the manner in which a claimed composite structure is intended to be employed does not differentiate the claimed composite structure from a prior art insulating panel satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

With regard to claim 21, Spielau is silent as to the thickness of the foam layer. However, such a variable would have been recognized by one skilled in the art to control the degree of adhesion of the foam layers to each other. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the foam layer having instantly claimed thickness, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. ***In re Aller***, 105 USPQ 233. Since thickness is recognized as a result-effective variable, differences in thickness will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such thickness is critical or provides unexpected results.

Double Patenting

9. Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No.09/472,088. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-21 of copending Application No.09/472,088 encompasses the claims 1-21 of the present application including an additional limitation of the thickness of the coating layer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Monday to Friday, 8:30 to 5:00 (EAST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
July 24, 2002

ELIZABETH M. COLE
PRIMARY EXAMINER